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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Atty. Ref. No.: 016756/0191

BRIDGESTONE/FIRESTONE
RESEARCH, INC. and

BRIDGESTONE/FIRESTONE, INC.
Opposers,

v.

Vredestein Fietsbanden B.V.
Applicant.



10-15-2001

U.S. Patent & TMO/TM Mail Rcpt Dt. #58

Opposition No. _____

NOTICE OF OPPOSITION

In the matter of an application for registration of the expression "PI-STONE" for "tires for vehicles and bicycles," Serial No. 78/010,596, filed May 31, 2000 by Vredestein Fietsbanden B.V., Broeckweg 29, 705 Al Doetinchem, NETHERLANDS (hereinafter called "applicant"), and published for opposition in the Official Gazette of September 18, 2001.

Bridgestone/Firestone Research, Inc., a Delaware corporation, having a business address at 1659 South Main Street, Akron, Ohio 44301, and Bridgestone/Firestone, Inc., an Ohio corporation, with a business address at 1200 Firestone Parkway, Akron, Ohio 44317-0001, believe that they would be damaged by registration as sought in the foregoing application and hereby oppose the same.

The grounds for the opposition are as follows:

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1. Bridgestone/Firestone Research, Inc. is a wholly owned subsidiary of Bridgestone/Firestone, Inc., (both hereinafter called "opposers"), formerly known as The Firestone Tire & Rubber Company (hereinafter called "Firestone").

2. By the application herein opposed, applicant seeks to register "PI-STONE" as a trademark for "tires for vehicles and bicycles," basing such application for United States federal registration on a claim of an intent to use the mark in commerce in connection with the identified goods.

3. Opposers, as the successors in interest to Firestone, are the owner of all right, title and interest in and to various FIRESTONE marks for vehicle tires and for other goods and services of opposer. As used herein, "opposers' goods," "opposers' services," and "opposers' business," as well as expressions to a similar effect, mean the goods, the services and the business of Firestone, which is the predecessor in title of opposers.

4. Opposers are also the owner of many U.S. Trademark and Service Mark Registrations featuring the mark FIRESTONE. Among such U.S. registrations are Reg. No. 140,804, registered March 29, 1921, for the mark FIRESTONE in a stylized form for rubber tires and other products, which registration is still in full force and effect. Other such U.S. registrations include Reg. No. 299,977; Reg. No. 378,189; Reg. No. 379,936; Reg. No. 385,161; Reg. No. 396,796; Reg. No. 401,421; Reg. No. 948,402; Reg. No. 1,178,631; Reg. 1,387,468; Reg. No. 1,445,182; Reg. No. 1,471,665; Reg. No. 1,685,164; and Reg. No. 2,223,630.

5. The term FIRESTONE was adopted as a mark and name by a predecessor of opposer more than one hundred years ago, in January, 1896, and has been used continuously since then to the present in connection with the advertising, promotion, sale and offering of opposer's "tires" and other goods in interstate commerce; and is still in such use by opposers.

6. Opposers use trade names and corporate identifiers dominated by the name "Bridgestone/Firestone." Such Bridgestone/Firestone name and identifier have been in use since long prior to any date on which applicant may rely in this proceeding. In this regard, the ultimate parent company of opposers is Bridgestone Corporation; and the mark and name BRIDGESTONE is often used with the mark and name FIRESTONE to create a unitary impression conveyed by a composite of the two marks and names BRIDGESTONE and FIRESTONE. Also, Firestone has a website accessed, not only by its domain name <firestone.com>, but also by its domain name <bridgestone-firestone.com>. Thus, as used herein, the expression "Bridgestone/Firestone name" and expressions to the same effect encompass the aforesaid Bridgestone/Firestone trade name and corporate identifier, the aforesaid composite expression composed of the terms BRIDGESTONE and FIRESTONE, and the aforesaid <bridgestone-firestone.com> domain name.

7. The FIRESTONE names and marks and the Bridgestone/Firestone name are of significant value to opposers as identifications of source in connection with the promotion, sale, rendering and offering of the goods and services of opposers and their affiliates, as well as in the conducting and identifying of the business of opposers and its affiliates; and such marks and names distinguish such goods, such services and such business from those of others.

8. Opposers and their affiliates have been using the FIRESTONE names and marks as well as the Bridgestone/Firestone name in connection with their goods, services, and business since prior to any date on which applicant may rely in this proceeding, and in particular, have been using such names and marks long prior to the filing date of the application herein opposed.

9. The FIRESTONE names and marks for vehicle tires and for other goods and services, as well as the Bridgestone/Firestone name, on the one hand, and the "PI-STONE" mark as sought to be registered by applicant for "tires for vehicles and bicycles", on the other hand, are similar in sound, spelling and appearance. Thus, the mark sought to be registered by applicant so resembles opposers' marks and names as to be likely to cause confusion, or to cause mistake, or to deceive.

10. The "tires for vehicles and bicycles" identified by the applicant's designation "PI-STONE" and the "rubber tires" identified by opposers' FIRESTONE marks and name and by the Bridgestone/Firestone name are identical. Applicant's goods and opposers' goods and other services and businesses are closely related kinds of goods, services and businesses and are typically offered and provided to the same classes of purchasers through the same channels of trade.

11. Through use and promotion by opposers and their affiliates of opposer's FIRESTONE names and marks and of the Bridgestone/Firestone name for opposer's goods, services and businesses, purchasers and prospective purchasers of such goods and services and/or of goods and services of the same general kind, as well as customers and prospective customers of such business, associate such marks with the goods, services and business of opposers.

12. Purchasers and prospective purchasers familiar with opposers' goods, services and businesses identified by the FIRESTONE marks and names and by the Bridgestone/Firestone name are likely to be misled into believing, contrary to fact, that applicant's goods sold under the mark opposed herein emanate from or are in some way sponsored by opposers or their affiliates, all to opposers' irreparable damage through loss and/or dilution of their good will as symbolized by opposers' marks and names.

13. Granting of a registration as sought by applicant through the application herein opposed would place applicant in a position to harass and cause annoyance to opposers and their customers, to the damage of opposers. Such registration would inhibit opposers in their free use of their FIRESTONE marks and name and their Bridgestone/Firestone name in selling their products, promoting their services, and conducting their business, which would work manifest damage upon opposers. Finally, such registration would constitute prima facie evidence of an exclusive right to use the designation "PI-STONE" for the goods designated in the application herein opposed and for all confusingly similar uses, thereby enabling applicant to occupy a position in the trade which would further compound confusion on the part of the purchasing public, all to the damage of opposers.

14. In view of extensive promotion and use thereof for more than a century and in view of the widespread renown and recognition thereby developed, opposers' FIRESTONE marks and names have long been famous marks and names. The Bridgestone/Firestone name is also famous. Such marks and names have been famous since long before any date on which applicant has used its PI-STONE mark and since long before any date on which applicant may rely for priority purposes in this proceeding. Applicant's PI-STONE mark, which is the subject

of the application opposed herein, causes and will cause dilution of the distinctive quality of opposers' famous FIRESTONE mark and name and of the Bridgestone/Firestone name, all to the further damage of opposers.

15. The application opposed herein was filed May 31, 2000, which was subsequent to January 16, 1996, the effective date of the federal anti-dilution statute embraced by Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c). Accordingly, the application herein opposed is subject to being opposed on the ground that the mark sought to be registered dilutes the distinctive quality of opposer's famous marks.

WHEREFORE, opposers request that this opposition be sustained and the subject application Serial No. 78/010,596 to register the mark PI-STONE be refused registration.

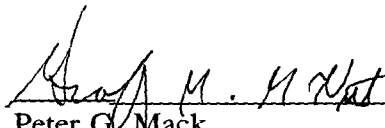
A check in the amount of \$600.00 is attached to cover the statutory filing fee.

Respectfully submitted,

Bridgestone/Firestone Research, Inc.
Bridgestone/Firestone, Inc.

October 15, 2001
Date:

By:


Peter G. Mack
Geoffrey M. McNutt,
Counsel for Opposer

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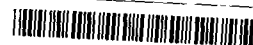
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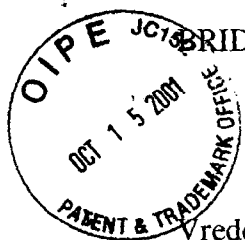
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TRANSMITTAL LETTER

The Honorable Commissioner of
Patents and Trademarks
Washington, D.C. 20231

Madam:

Please find attached hereto the following items:

1. Notice of Opposition (in duplicate)
2. Check (\$300.00) Covering Filing Fee

Please charge any additional fees due to Deposit Account No. 19-0741. A duplicate of this letter is attached for this purpose.

Respectfully submitted,

October 15, 2001

By: _____

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